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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91227978
Party	Plaintiff Combined Insurance Company of America
Correspondence Address	TIMOTHY D PECSENYE BLANK ROME LLP ONE LOGAN SQUARE PHILADELPHIA, PA 19103 UNITED STATES pecsenye@blankrome.com, mhomyk@blankrome.com
Submission	Motion to Strike Pleading/Affirmative Defense
Filer's Name	Matthew A. Homyk
Filer's e-mail	mhomyk@blankrome.com
Signature	/matthew homyk/
Date	07/19/2016
Attachments	motion to strike.pdf(59841 bytes )

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

In re Application of The Insurance Source

Application No.: 86/734,955

Filed: August 24, 2015

Mark: WE MAKE HEALTH INSURANCE EASIER.

Opposition No.: 91227978

Combined Insurance Company of America,	:
an Illinois corporation,	:
	:
Opposer,	:
	:
v.	:
	:
The Insurance Source,	:
a South Carolina corporation,	:
	:
Applicant.	:
	:

Hon. Commissioner for Trademarks  
P.O. Box 1451  
Alexandria, Virginia 22313-1451  
Attn.: Trademark Trial and Appeal Board

**MOTION TO STRIKE ANSWER TO NOTICE OF OPPOSITION**

Opposer Combined Insurance Company of America hereby moves to strike the Answer to the Notice of Opposition ("Answer") filed by Applicant, The Insurance Source, on the grounds that

the pleading is legally insufficient and service upon Opposer's counsel was never attempted by mail as required by the rules.

#### **BACKGROUND**

On May 18, 2016, Opposer filed a Notice of Opposition to U.S. Serial No. 86/734,955. On May 19, 2016, the Board issued an order containing the trial schedule and identifying the deadline to file an answer as June 28, 2016. On May 27, 2016, Applicant's then existing counsel filed a Request to Withdraw as Attorney. On May 31, 2016, the Board denied Applicant's counsel's motion to withdraw as counsel, and set a new 30-day deadline for counsel to file a new motion to withdraw. On June 1, 2016, Applicant's counsel filed another motion to withdraw, which was granted by the Board later the same day. On June 14, 2016, Applicant filed an argumentative brief under the title "Answer," but has not served a copy of this "Answer" on Opposer by mail. On July 14, 2016, Applicant sent a copy of its "Answer" to Opposer's counsel via email; upon review of this responsive pleading, Opposer asserts the Answer is legally insufficient and flawed.

F.R.C.P. Rule 12(c) states,

The court may strike from a pleading an insufficient defense or any redundant, immaterial, impertinent, or scandalous matter. The court may act:

(1) on its own; or

(2) on motion made by a party either before responding to the pleading or, if a response is not allowed, within 21 days after being served with the pleading (26 days, if service of the pleading was made by first-class mail, "Express Mail," or overnight courier. See TBMP § 506.02; 37 CFR § 2.119(c)).

Based on the following facts and arguments outlined in this motion regarding the patent flaws inherent in the Answer and the lack of a Certificate of Service, Opposer moves to strike the Answer in its entirety.

### **ARGUMENT**

#### **I. The Answer is Legally Deficient**

Applicant's Answer is legally deficient and highly prejudicial to Opposer. Under TBMP § 503, "upon motion, or upon its own initiative, the Board may order stricken from a pleading any insufficient defense or any redundant, immaterial, impertinent, or scandalous matter" (citing *Ohio State University v. Ohio University*, 51 USPQ2d 1289, 1293 (TTAB 1999) (motion to strike certain allegations in the counterclaim) and *Western Worldwide Enterprises Group Inc. v. Qingdao Brewery*, 17 USPQ2d 1137 (TTAB 1990) (motion to strike allegations of

geographic descriptiveness asserted against registration over five years old granted)). The Board has the additional authority to strike an impermissible or insufficient claim (or portion thereof) from a pleading.

The requirements for an answer are outlined in TBMP § 311.01(a). While the foregoing section clearly states that an answer need not follow a particular format, it is mandatory that the pleading meet the stated requirements and that it include "the necessary information." See TBMP § 311.01(a). It is further stated that in terms of formatting, an answer is similar in format to a complaint. Quite simply, an answer must contain admissions and/or denials of the allegations in the complaint and may include any defenses to those allegations. See TBMP § 311.02.

"The defendant should not argue the merits of the allegations in a complaint but rather should state, as to each of the allegations contained in the complaint, that the allegation is either admitted or denied. TBMP § 311.02(a); 37 CFR §§ 2.106(b)(1) and 2.114(b)(1); F.R.C.P. 8(b); *Hewlett-Packard Co. v. Olympus Corp.*, 931 F.2d 1551, 18 USPQ2d 1710, 1713 (Fed. Cir. 1991); *Turner Entertainment Co. v. Ken Nelson*, 38 USPQ2d 1942 (TTAB 1996) (applicant's answers were

argumentative and nonresponsive and Board was ultimately forced to interpret the answer); *National Football League v. Jasper Alliance Corporation*, 16 USPQ2d 1212 (TTAB 1990) (applicant's answer was more in the nature of argument than answer); and *Thrifty Corp. v. Bomax Enterprises*, 228 USPQ 62, 63 (TTAB 1985). Furthermore, if the defendant does not have sufficient information to admit or deny an allegation, the defendant may so state, and this statement will have the effect of a denial as to that allegation. If the complaint consists of numbered paragraphs setting forth the basis of plaintiff's claim of damage, the defendant's admissions or denials should be made in numbered paragraphs corresponding to the numbered paragraphs in the complaint. TBMP § 311.02(a). "In the absence of a general denial of some or all of the allegations in a complaint, admissions or denials should be made in numbered paragraphs corresponding to the numbered paragraphs in the complaint." *Id.* (emphasis added)

The elements of a defense should be stated simply, concisely, and directly. See F.R.C.P. 8(e)(1). In *Turner Entertainment Co. v. Ken Nelson*, 38 USPQ2d 1942 (TTAB 1996), the Board found that "[t]here were problems regarding applicant's answer (applicant is pro se), most significantly in that the

pleadings were argumentative, nonresponsive and otherwise not in compliance with Fed.R.Civ.P. 8(b)." In *Turner*, the Board interpreted the applicant's pleading on its own initiative and then set forth a list of various admissions that it felt had been made by the Applicant. In the present case, it is the opinion of Opposer that the Answer should be stricken rather than interpreted by the Board.

Here, the Answer is argumentative, difficult to interpret, unresponsive to the numbered claims and allegations set forth in the Notice of Opposition, and difficult to comprehend. Furthermore, it is saturated with arguments and random commentary and makes an accusation of "trademark bullying" against Opposer's counsel, all of which is irrelevant to the allegations outlined in the Notice of Opposition and the issues presently before the Board. The answer is not the appropriate venue for submitting arguments in support of registration of a mark or accusations against opposing counsel. Instead, the purpose of the answer is to address and respond to the specific allegations set forth in the Notice of Opposition. Such is clearly lacking in this case.

Opposer is unable to decipher those allegations Applicant denies from those admitted. Without being able to determine the

allegations that have been denied from those which have been admitted, Opposer cannot proceed with an effective discovery plan. Thus, if the Answer is allowed to remain on the record without amendment, Opposer will be prejudiced in that it does not know which of the allegations are admitted or denied. This will certainly impact the discovery process, requiring needless and perhaps duplicative discovery requests, including requests for admission, thereby wasting the resources of all parties involved in this matter, as well as those of the Board.

Opposer has failed to comply with the basic rules and is essentially wasting the resources of the Board and Opposer. Due to the insufficiencies of the Answer as noted herein, and given the fact that Applicant had sufficient time to prepare and file an answer that complied with the Trademark Rules, Opposer motions the Board to strike the Answer in its entirety.

**II. The Certificate of Service and Manner of Service is Improper**

Under 37 CFR § 2.119, TBMP § 113, every document filed in an inter partes proceeding before the Board must be served by the filing party upon every other party to the proceeding. When a party to an inter partes proceeding before the Board files a document required by 37 CFR § 2.119(a), to be served upon every

other party to the proceeding, proof that the required service has been made ordinarily must be submitted before the filing will be considered by the Board. See TBMP § 113.02. Furthermore, TBMP § 113.03 also states, in part: "The Board will accept, as prima facie proof that a party filing a document in a Board inter partes proceeding has served a copy of the document upon every other party to the proceeding, a statement signed by the filing party, or by its attorney or other authorized representative, clearly stating the date and manner in which service was made. The statement should also specify the name of each party or person upon whom service was made, and the address. The statement must appear on, or be securely attached to, the document being filed."

Under TBMP § 311.01(c) and 37 CFR § 2.119(a), "[t]he answer must bear proof (e.g., a certificate of service, consisting of a statement signed by the filing party, or by its attorney or other authorized representative, clearly stating the date and manner in which service was made) that such service has been made before the paper will be considered by the Board."

37 CFR § 2.119(b) provides several means of acceptable service upon an opposing party or its counsel, as follows:

- (1) by hand delivering a copy of the submission to the person being served;
- (2) by leaving a copy of the submission at the usual place of business of the person being served, with someone in the person's employment;
- (3) when the person being served has no usual place of business, by leaving a copy of the submission at the person's address, with a member of the person's family over 14 years of age and of discretion;
- (4) transmission by the "Express Mail Post Office to Addressee" service of the United States Postal Service or by first-class mail, which may also be certified or registered; and
- (5) transmission by overnight courier. In addition, whenever it is satisfactorily shown to the Director that none of the specified modes of service is practicable, service may be made by notice published in the Official Gazette of the USPTO.

Applicant electronically filed its Answer with the Board on June 14, 2016. The Answer did not include or incorporate a certificate of service.

Due to the lack of proper service of the Answer, Opposer motions the Board to strike the Answer in its entirety.

**CONCLUSION**

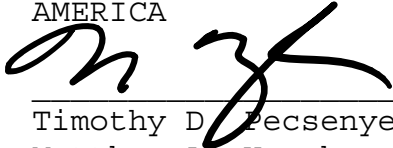
WHEREFORE, Opposer requests that the Answer filed on June 14, 2016 be stricken from the record on the grounds that the pleading is unresponsive, argumentative, and redundant and is legally insufficient in terms of form and content and on the basis that service was improper.

Respectfully submitted,

COMBINED INSURANCE COMPANY OF  
AMERICA

Date: July 19, 2016

By:

  
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Timothy D. Pecsénye  
Matthew A. Homyk  
Its Attorneys

BLANK ROME LLP  
ONE LOGAN SQUARE  
PHILADELPHIA, PA 19103  
(215) 569-5619

CERTIFICATE OF SERVICE

I, Matthew A. Homyk, do hereby certify that I have on July 19, 2016, mailed via first class mail, the foregoing MOTION TO STRIKE ANSWER TO NOTICE OF OPPOSITION to the following:

Guy V. Furay  
The Insurance Source  
114 Trade Street  
Greer, SC 29651  
guy@insure-u.com, team@insure-u.com



Matthew A. Homyk